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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,440	04/12/2004	Wai Ming Choi	072545-0083	1434

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BOSTON, MA 02210-2604

EXAMINER
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PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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10/17/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/822,440	<b>Applicant(s)</b> CHOI ET AL.	
	<b>Examiner</b> Andrew T. Piziali	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/4/2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what gamma value constitutes a gamma value of "at least about" 14. In addition, it is not clear what apparent density constitutes an apparent density of "at least about" 0.15 g/cc.

The court has held that claims reciting "at least about" are invalid for indefiniteness where there is close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term "about." *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991). See MPEP 2173.05(b).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-14 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong.

Regarding claims 13-14 and 19-20, Pierce discloses a nonwoven filter media comprising a layer of glass wool fibers combined with chopped glass fibers (see entire document including page 2, lines 23-25). Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and that the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29). Pierce discloses that the glass wool fibers may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14). Pierce discloses that the chopped glass fibers may have a diameter in the range of 5.0 to 9.0 microns (page 7, lines 22-24). Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18). Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer.

Pierce does not appear to mention varying the pH of the nonwoven glass layer during the wet laid process, but Dong discloses that it is known in the wet laid nonwoven glass art to sequence the addition of oppositely charged viscosity modifiers so that the glass fibers are initially dispersed and then attracted together resulting in a pH in the range of from about 5 to

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about 10 and resulting in a nonwoven glass layer with uniform weight (see entire document including column 2, lines 20-33 and column 6, lines 58-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the pH of the nonwoven glass layer during the wet laid process, as taught by Dong, because the nonwoven filter media would advantageously possess a uniform weight.

Pierce does not mention the gamma value, but considering that the nonwoven filter media taught by the applied prior art is substantially identical to the claimed nonwoven filter media in structure and considering that the nonwoven filter media taught by the applied prior art is made by a substantially identical wet laid process, it appears that the nonwoven filter media inherently possesses the claimed gamma value.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Regarding claim 14, Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14).

Regarding claims 19 and 20, Pierce discloses that the glass wool fibers may be combined with chopped glass fibers forming a filtration layer (see entire document including page 2, lines 23-25).

Regarding claim 20, Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29).

6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong as applied to claims 13-14 and 19-20 above, and further in view of USPN 4,102,785 to Head et al. (hereinafter referred to as Head).

Pierce does not appear to mention the apparent density of the web, therefore, it would have been obvious to look to the prior art for conventional web densities. Head provides this conventional teaching showing that it is known in the filter art to use a fiber density of about 0.15 to 0.25 g/cc (see column 4, lines 52-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filter media with a fiber density of 0.15 to 0.25 g/cc, as taught by Head, motivated by the expectation of successfully practicing the invention of Pierce.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong as applied to claims 13-14 and 19-20 above, and further in view of USPN 6,749,753 to Yamaguchi et al. (hereinafter referred to as Yamaguchi).

Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer. Pierce

does not appear to mention using a larger fiber diameter in one of the supporting plies, but Yamaguchi discloses that it is known in the filtration art to vary the fiber diameter of adjacent plies to increase filtration accuracy and increase filtration life (see entire document including column 2, lines 29-44). Yamaguchi discloses that the larger fibers may have a diameter of 1.1 to 20 times as large as the smaller diameter (column 6, lines 38-49). Considering that Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14), it would have been obvious to use fibers with a diameter of 0.69 microns in one ply and fibers with a diameter of 4.2 microns in at least one of the supporting plies, because the filter would possess increased filtration accuracy and increased filtration life.

8. Claims 1-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong in view of USPN 6,420,024 to Perez et al. (hereinafter referred to as Perez).

Regarding claims 1-17 and 19-20, Pierce discloses a nonwoven filter media comprising a layer of glass wool fibers combined with chopped glass fibers (see entire document including page 2, lines 23-25). Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and that the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29). Pierce discloses that the glass wool fibers may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14). Pierce discloses that the chopped glass fibers may have a diameter in the range of 5.0 to 9.0 microns (page 7, lines 22-24). Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18).

Pierce does not appear to mention varying the pH of the nonwoven glass layer during the wet laid process, but Dong discloses that it is known in the wet laid nonwoven glass art to

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sequence the addition of oppositely charged viscosity modifiers so that the glass fibers are initially dispersed and then attracted together resulting in a pH in the range of from about 5 to about 10 and resulting in a nonwoven glass layer with uniform weight (see entire document including column 2, lines 20-33 and column 6, lines 58-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the pH of the nonwoven glass layer during the wet laid process, as taught by Dong, because the nonwoven filter media would advantageously possess a uniform weight.

Pierce appears to be silent with regards to a specific surface area, therefore, it would have been obvious to look to the prior art for conventional surfaces areas. Perez provides this conventional teaching showing that it is known in the filtration art to use a surface area of greater than  $0.25 \text{ m}^2/\text{gm}$ , typically about  $0.5$  to  $30 \text{ m}^2/\text{g}$  (see column 2, lines 8-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the surface area from about  $0.5$  to  $30 \text{ m}^2/\text{g}$ , motivated by the expectation of successfully practicing the invention of Pierce.

Pierce does not mention the gamma value, but considering that the nonwoven filter media taught by the applied prior art is substantially identical to the claimed nonwoven filter media in structure and considering that the nonwoven filter media taught by the applied prior art is made by a substantially identical wet laid process, it appears that the nonwoven filter media inherently possesses the claimed gamma value.

Regarding claims 2-3, 9-10 and 14, Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of  $0.1$  to  $5.0$  microns (page 6, lines 12-14).



Regarding claims 4-6 and 19-20, Pierce discloses that the glass wool fibers may be combined with chopped glass fibers forming a filtration layer (see entire document including page 2, lines 23-25).

Regarding claims 6 and 20, Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29).

Regarding claims 7 and 11, Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18).

Regarding claims 8-12 and 16-17, Pierce does not appear to mention the apparent density of the web, but considering that the nonwoven filter media taught by the applied prior art possesses an identical surface area and is made with an identical wet laid process producing a substantially uniform web, it appears that the apparent density of the web is inherently at least about 0.15 g/cc.

Regarding claims 13-17 and 19-20, Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer.

9. Claims 8-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong in view of USPN 6,420,024 to Perez as applied to claims 1-17 and 19-20 above, and further in view of USPN 4,102,785 to Head.

Pierce does not appear to mention the apparent density of the web, but considering that the nonwoven filter media taught by the applied prior art possesses an identical surface area and is made with an identical wet laid process producing a substantially uniform web, it appears that the apparent density of the web is inherently at least about 0.15 g/cc. In the event that it is shown that the apparent density of the web is not inherently about 0.15 to 0.21 g/cc, Head discloses that it is known and typical in the filter art to use a fiber density of about 0.15 to 0.25 g/cc (see column 4, lines 52-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filter media with a fiber density of 0.15 to 0.25 g/cc, as taught by Head, because it is understood by one of ordinary skill in the art that the apparent density effects a property such as filtration efficiency and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 6,291,552 to Dong in view of USPN 6,420,024 to Perez as applied to claims 1-17 and 19-20 above, and further in view of USPN 6,749,753 to Yamaguchi.

Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer. Pierce does not appear to mention using a larger fiber diameter in one of the supporting plies, but Yamaguchi discloses that it is known in the filtration art to vary the fiber diameter of adjacent plies to increase filtration accuracy and increase filtration life (see entire document including column 2, lines 29-44). Yamaguchi discloses that the larger fibers may have a diameter of 1.1 to 20 times as large as the smaller diameter (column 6, lines 38-49). Considering that Pierce

discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14), it would have been obvious to use fibers with a diameter of 0.69 microns in one ply and fibers with a diameter of 4.2 microns in at least one of the supporting plies, because the filter would possess increased filtration accuracy and increased filtration life.

11. Claims 13-14 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 4,523,995 to Pall et al. (hereinafter referred to as Pall).

Regarding claims 13-14 and 19-20, Pierce discloses a nonwoven filter media comprising a layer of glass wool fibers combined with chopped glass fibers (see entire document including page 2, lines 23-25). Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and that the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29). Pierce discloses that the glass wool fibers may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14). Pierce discloses that the chopped glass fibers may have a diameter in the range of 5.0 to 9.0 microns (page 7, lines 22-24). Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18). Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer.

Pierce does not appear to mention varying the pH of the nonwoven glass layer during the wet laid process, but Pall discloses that it is known in the wet laid nonwoven glass art to vary the resulting pH in the range of from about 7 to about 10 to result in a nonwoven glass layer with excellent strength and enhanced particulate removal efficiency (see entire document including column 2, lines 34-46, the paragraph bridging columns 5 and 6, and column 6, lines 52-63). It

would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the pH of the nonwoven glass layer during the wet laid process to about 7 to about 10, as taught by Pierce, because the nonwoven filter media would advantageously possess excellent strength and enhanced particulate removal efficiency.

Pierce does not mention the gamma value, but considering that the nonwoven filter media taught by the applied prior art is substantially identical to the claimed nonwoven filter media in structure and considering that the nonwoven filter media taught by the applied prior art is made by a substantially identical wet laid process, it appears that the nonwoven filter media inherently possesses the claimed gamma value.

Regarding claim 14, Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14).

Regarding claims 19 and 20, Pierce discloses that the glass wool fibers may be combined with chopped glass fibers forming a filtration layer (see entire document including page 2, lines 23-25).

Regarding claim 20, Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29).

12. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 4,523,995 to Pall as applied to claims 13-14 and 19-20 above, and further in view of USPN 4,102,785 to Head.

Pierce does not appear to mention the apparent density of the web, therefore, it would have been obvious to look to the prior art for conventional web densities. Head provides this

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conventional teaching showing that it is known in the filter art to use a fiber density of about 0.15 to 0.25 g/cc (see column 4, lines 52-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filter media with a fiber density of 0.15 to 0.25 g/cc, as taught by Head, motivated by the expectation of successfully practicing the invention of Pierce.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 4,523,995 to Pall as applied to claims 13-14 and 19-20 above, and further in view of USPN 6,749,753 to Yamaguchi.

Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer. Pierce does not appear to mention using a larger fiber diameter in one of the supporting plies, but Yamaguchi discloses that it is known in the filtration art to vary the fiber diameter of adjacent plies to increase filtration accuracy and increase filtration life (see entire document including column 2, lines 29-44). Yamaguchi discloses that the larger fibers may have a diameter of 1.1 to 20 times as large as the smaller diameter (column 6, lines 38-49). Considering that Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14), it would have been obvious to use fibers with a diameter of 0.69 microns in one ply and fibers with a diameter of 4.2 microns in at least one of the supporting plies, because the filter would possess increased filtration accuracy and increased filtration life.

14. Claims 1-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 4,523,995 to Pall in view of USPN 6,420,024 to Perez.

Regarding claims 1-17 and 19-20, Pierce discloses a nonwoven filter media comprising a layer of glass wool fibers combined with chopped glass fibers (see entire document including page 2, lines 23-25). Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and that the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29). Pierce discloses that the glass wool fibers may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14). Pierce discloses that the chopped glass fibers may have a diameter in the range of 5.0 to 9.0 microns (page 7, lines 22-24). Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18).

Pierce does not appear to mention varying the pH of the nonwoven glass layer during the wet laid process, but Pall discloses that it is known in the wet laid nonwoven glass art to vary the resulting pH in the range of from about 7 to about 10 to result in a nonwoven glass layer with excellent strength and enhanced particulate removal efficiency (see entire document including column 2, lines 34-46, the paragraph bridging columns 5 and 6, and column 6, lines 52-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the pH of the nonwoven glass layer during the wet laid process to about 7 to about 10, as taught by Pierce, because the nonwoven filter media would advantageously possess excellent strength and enhanced particulate removal efficiency.

Pierce appears to be silent with regards to a specific surface area, therefore, it would have been obvious to look to the prior art for conventional surfaces areas. Perez provides this conventional teaching showing that it is known in the filtration art to use a surface area of greater than  $0.25 \text{ m}^2/\text{gm}$ , typically about  $0.5$  to  $30 \text{ m}^2/\text{g}$  (see column 2, lines 8-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

make the surface area from about 0.5 to 30 m<sup>2</sup>/g, motivated by the expectation of successfully practicing the invention of Pierce.

Pierce does not mention the gamma value, but considering that the nonwoven filter media taught by the applied prior art is substantially identical to the claimed nonwoven filter media in structure and considering that the nonwoven filter media taught by the applied prior art is made by a substantially identical wet laid process, it appears that the nonwoven filter media inherently possesses the claimed gamma value.

Regarding claims 2-3, 9-10 and 14, Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14).

Regarding claims 4-6 and 19-20, Pierce discloses that the glass wool fibers may be combined with chopped glass fibers forming a filtration layer (see entire document including page 2, lines 23-25).

Regarding claims 6 and 20, Pierce discloses that the chopped glass fibers may be present in the range of about 5 to 40% by weight and the glass wool fibers may be present in the range of about 60 to 95% by weight (page 2, lines 27-29).

Regarding claims 7 and 11, Pierce discloses that the filter media may be a wet laid filter media (page 14, lines 17-18).

Regarding claims 8-12 and 16-17, Pierce does not appear to mention the apparent density of the web, but considering that the nonwoven filter media taught by the applied prior art possesses an identical surface area and is made with an identical wet laid process producing a substantially uniform web, it appears that the apparent density of the web is inherently at least about 0.15 g/cc.

Regarding claims 13-17 and 19-20, Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page 10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer.

15. Claims 8-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 4,523,995 to Pall in view of USPN 6,420,024 to Perez as applied to claims 1-17 and 19-20 above, and further in view of USPN 4,102,785 to Head.

Pierce does not appear to mention the apparent density of the web, but considering that the nonwoven filter media taught by the applied prior art possesses an identical surface area and is made with an identical wet laid process producing a substantially uniform web, it appears that the apparent density of the web is inherently at least about 0.15 g/cc. In the event that it is shown that the apparent density of the web is not inherently about 0.15 to 0.21 g/cc, Head discloses that it is known and typical in the filter art to use a fiber density of about 0.15 to 0.25 g/cc (see column 4, lines 52-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filter media with a fiber density of 0.15 to 0.25 g/cc, as taught by Head, because it is understood by one of ordinary skill in the art that the apparent density effects a property such as filtration efficiency and because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

16. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/43850 to Pierce in view of USPN 4,523,995 to Pall in view of USPN 6,420,024 to Perez as applied to claims 1-17 and 19-20 above, and further in view of USPN 6,749,753 to Yamaguchi.

Pierce discloses that the number of plies can vary from approximately 1 to 10 plies (page



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10, lines 30-31). Therefore, the top ply can be considered to read on the claimed filtration layer and one or more underlying plies can be considered to read on the claimed support layer. Pierce does not appear to mention using a larger fiber diameter in one of the supporting plies, but Yamaguchi discloses that it is known in the filtration art to vary the fiber diameter of adjacent plies to increase filtration accuracy and increase filtration life (see entire document including column 2, lines 29-44). Yamaguchi discloses that the larger fibers may have a diameter of 1.1 to 20 times as large as the smaller diameter (column 6, lines 38-49). Considering that Pierce discloses that the glass wool fibers of each ply may have a diameter in the range of 0.1 to 5.0 microns (page 6, lines 12-14), it would have been obvious to use fibers with a diameter of 0.69 microns in one ply and fibers with a diameter of 4.2 microns in at least one of the supporting plies, because the filter would possess increased filtration accuracy and increased filtration life.

### ***Response to Arguments***

17. Applicant's arguments filed 10/4/2007 and the declaration filed 10/4/2007 have been fully considered but they are not persuasive.

Firstly, it is not clear what gamma value constitutes a gamma value of "at least about" 14. It is feasible that one could construe the specification as indicating a gamma value that does not exceed 13 is considered a gamma value of at least about 14 (see abstract and [0019]), but then applicant's specification and declaration filed on 10/4/2007 appear to teach that the nonwoven filter media taught by the applied prior art inherently possesses the claimed gamma value.

The court has held that claims reciting “at least about” are invalid for indefiniteness where there is close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term “about.” *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991). See MPEP 2173.05(b).

Although the examiner sincerely appreciates the time and effort that went into drafting the declaration filed on 10/4/2007, the declaration fails to show that the claimed gamma value (at least about 14) is a direct result of step 1) adding an acidic adjusting agent and step 2) adding a neutral or basic (alkaline) adjusting agent.

The applied prior art teaches adding a base only while the applicant asserts that the claimed invention can only be obtained by adding an acid and then a base. Therefore, a comparison of Tables C and D is appropriate to evaluate the patentability of the current claims. Unfortunately, as explained below, none of the samples from Table C are comparable to the samples of Table D.

Samples C1 and C2 have a mold pH with fiber slurry of 6.6, while all of the samples in Table D have a mold pH with fiber slurry of at least 7. That eliminates samples C1 and C2 from comparison.

Samples C5 and C6 have a mold pH with fiber slurry of 8.6 and 8.8, respectively, but none of the sample in Table D have a mold pH with fiber slurry of 8.5, 8.6, 8.7 or 8.8. Although sample D5 of Table D has a mold pH with fiber slurry of 8.9, no gamma value is disclosed for this sample. That eliminates samples C5 and C6 from comparison.

Samples C3 and C4 have a mold pH with fiber slurry of 6.9 and 7.0, respectively, while samples D1 and D2 in Table D have a mold pH with fiber slurry of 7.0. Therefore, these samples are comparable and illustrate an example of the base only teachings of the applied prior art compared to the acid and base teaching of the specification. Unfortunately, the C3, C4, D1 and D2 filter medias created with similar fiber slurry pH values possess different basis weights, calipers, apparent densities, and surface areas. For example, samples C2 and C3 have surface areas of 1.81 and 1.91, respectively, while samples D1 and D2 have much higher surface areas of 1.95 and 2.01, respectively. It is not clear which factor(s) is influencing the measured gamma value and thus it can not be determined that that process of adding an acid and then a base, rather than adding just a base, is responsible for the higher gamma values disclosed in Table D compared to Table C. Therefore, the applicant has failed to show that the nonwoven filter media taught by the applied prior does not inherently possesses the claimed gamma value.

In response to applicant's argument that Dong is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Dong is in the field of applicant's endeavor which is wet laid methods of making glass fiber mats (see column 1, lines 4-11 of Dong and [0003] of the current specification).

In response, the applicant asserts that the field of applicant's endeavor is wet laid glass fiber mat filter media not wet laid glass fiber mats. The examiner respectfully disagrees. The fields overlap.

Regarding the rejections in view of Perez, the applicant asserts that the surface area cannot merely be modified to have a specific value. The applicant asserts that the surface area "has to be achieved." Applicant's statement is noted, but regardless, Perez provides this conventional teaching showing that it is known in the filtration art to use a surface area of greater than 0.25 m<sup>2</sup>/gm, typically about 0.5 to 30 m<sup>2</sup>/g (see column 2, lines 8-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the surface area from about 0.5 to 30 m<sup>2</sup>/g, motivated by the expectation of successfully practicing the invention of Pierce.

In response, the applicant asserts that Perez would have to disclose exactly how to obtain the surface area because one skilled in the art would be unable to obtain the disclosed surface area. The examiner respectfully disagrees. One skilled in the art is just that, one with skill in the art. Therefore, one skilled in the art is well aware of conventional methods to vary surface area. It is noted that the applicant has failed to show, or attempt to show, that one skilled in the art would be unable to obtain the surface area disclosed by Perez. It is well settled that unsupported arguments are no substitute for objective evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

The applicant asserts that there is no motivation to combine Pierce and Pall. The examiner respectfully disagrees. Pierce does not appear to mention varying the pH of the nonwoven glass layer during the wet laid process, but Pall discloses that it is known in the wet laid nonwoven glass art to vary the resulting pH in the range of from about 7 to about 10 to result in a nonwoven glass layer with excellent strength and enhanced particulate removal efficiency (see entire document including column 2, lines 34-46, the paragraph bridging columns 5 and 6,

and column 6, lines 52-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the pH of the nonwoven glass layer during the wet laid process to about 7 to about 10, as taught by Pierce, because the nonwoven filter media would advantageously possess excellent strength and enhanced particulate removal efficiency.

In response, the applicant asserts that adding a binder during processing, as taught by Palls, will not enhance the strength or efficiency of the filter media. The examiner respectfully disagrees. Palls discloses the opposite (see entire document including column 2, lines 34-46). In addition, common sense teaches that the addition of a binder increases (binding) strength.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Andrew T Piziali/

Primary Examiner, Art Unit 1794